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D. REMARKS**Status of the Claims**

Claims 1-20 are currently present in the Application, and claims 1, 9, and 13 are independent claims. No claims have been amended, cancelled, or added in this Response.

Drawings

The Office Action did not indicate whether the formal drawings filed by the Applicant are accepted by the Examiner. Applicant respectfully requests that the Examiner indicate whether the drawings filed on March 26, 2001 are accepted by the Examiner in the next communication.

Amendments to the Specification

The specification has been amended to add the serial numbers of the related applications.

Claim Rejections - Alleged Anticipation Under 35 U.S.C. § 102
And Alleged Obviousness Under 35 U.S.C. § 103

Claims 1-3, 9, and 12-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lewis, U.S. Patent No. 6,779,720 (hereinafter Lewis). Claims 4-8, 10-11, and 16-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis. Applicant respectfully traverses the rejections.

1. Declaration under 37 C.F.R. § 1.131 removing Lewis as a prior art reference

Applicant respectfully asserts that Applicant conceived of the claimed invention prior to the filing date of Lewis, and that Applicant showed diligence from Applicant's conception date to the filing date of Applicant's application. A declaration,

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pursuant to 37 C.F.R. § 1.131, has been duly executed by Applicant Rabindranath Dutta and is included with this Response. Mr. Dutta declares that Applicant's claimed invention was conceived of prior to January 19, 2001 and that diligence was shown in filing the Application on March 26, 2001. Exhibit "A" to Mr. Dutta's declaration is a copy of the IBM invention disclosure that disclosed Applicant's invention. The Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to January 19, 2001. The Disclosure was then evaluated and sent to an attorney for filing. As Mr. Dutta states in his declaration, he worked diligently with the attorney in order to file the Application on March 26, 2001. Mr. Dutta's declaration under 37 C.F.R. § 1.131, therefore, removes the Lewis patent from consideration as prior art.

Based on the above removal of the Lewis patent as prior art, Applicant respectfully submits that claims 1-20 are in condition for allowance.

2. Additional comments regarding alleged obviousness under 35 U.S.C. § 103

Notwithstanding the allowability of claims 1-20 as discussed above, Applicant would like to note that the Examiner's rejections of claims 4-8, 10-11, and 16-20 under 35 U.S.C. § 103(a) are not well-founded and do not meet the requirements of the Manual of Patent Examining Procedure, §§ 2142 and 2143.

The Manual of Patent Examining Procedure (MPEP) § 2142 sets forth the requirements for establishing an obviousness rejection:

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion

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or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

According to the MPEP § 2143.01 (emphasis added):

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation to do so** found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

According to the MPEP § 2143.03 (emphasis added):

To establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully asserts that the Examiner has not met the burden set forth in MPEP §§ 2142, 2143.01, and 2143.03 with regard to the rejection of dependent claims 4-8, 10-11, and 16-20. As an initial matter, the Examiner has not met the requirements of MPEP § 2143.03 because the Examiner has not shown that all claim limitations are taught or suggested by the prior art. The Examiner admits that Lewis does not disclose

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many, and in some cases all, of the elements found in dependent claims 4-8, 10-11, and 16-20. The Examiner merely asserts that "an authentication server acting as a proxy or agent to provide authentication service (e.g. receiving authorization, storing authorization and authenticating the receiver before secure information is released) is old and well known" (see Office Action, page 4, lines 19-21; page 5, lines 9-11; and page 6, lines 7-8). The Examiner also asserts that "using public key system (sic) for authentication is old and well known" (see Office Action, page 5, lines 15-16). The Examiner further asserts that "updating secure information (e.g. merchant has changed public key) from a user to the authentication server is old and well known" (see Office Action, page 6, lines 12-13).

The Examiner provides absolutely no rationale or support for these bare assertions that elements of Applicant's claims are "old and well known." The Examiner does not state any time frame in his assertion, merely stating that each feature "*is* old and well known." Does the Examiner mean that these features are **currently** regarded as old and well known, or does the Examiner mean that these features **were** old and well known when Applicant filed the Application? If these elements are currently regarded as "old and well known," that has absolutely no bearing on the patentability of Applicant's claims. If, however, the Examiner means to assert that these elements **were** "old and well known," the Examiner is obligated to produce prior art showing, that **at the time Applicant filed his invention**, these features were indeed old and well known. A bare assertion by the Examiner, without any supporting documentation or cited prior art, is simply not sufficient evidence that these features were old and well known. Without a citation to valid prior art, i.e. prior art that meets the requirements of 35 U.S.C. §§ 102 and 103, the

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Examiner has not met the burden of showing that all claim limitations are taught or suggested by the prior art.

Applicant further asserts that the Examiner has not met the burden of MPEP § 2143.01 because the Examiner has not shown any motivation to modify the teachings of the prior art to produce the claimed invention. The Examiner has not provided any motivation to modify the Lewis patent, either in Lewis itself, or in the Examiner's hypothetical "old and well known" prior art. Rather, the Examiner appears to be using Applicant's claims as guideposts in the examination of Applicant's claims. Therefore, the Examiner is using impermissible hindsight in combining the Lewis patent with Examiner's "hypothetical well known prior art."

Although the Examiner did not state that he was taking Official Notice of any facts not in the record, Applicant does understand that "[i]n limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on 'common knowledge' in making a rejection, however such rejections should be judiciously applied" (MPEP § 2144.03). However, Applicant notes that MPEP § 2144.03 further states that (emphasis added):

A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the

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notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. In *re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. In *re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to

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the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated " 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation..The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.").

B. If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). In certain older cases, official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on

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documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). If such notice is taken, the basis for such reasoning must be set forth explicitly. **The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.** See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. **The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.**

If it was the Examiner's intention to take Official Notice that the elements in dependent claims 4-8, 10-11, and 16-20, then Applicant challenges the Examiner's Official Notice. Applicant asserts that the elements found in dependent claims 4-8, 10-11, and 16-20 are not capable of instant and unquestionable demonstration as being well known as required by MPEP § 2144.03. The Examiner has not taken Official Notice that each and every limitation found in dependent claims 4-8, 10-11, and 16-20 is old and well known, but rather, has made a blanket statement that because authentication servers, public key systems, and updating secure information is old and well known (assertions with which Applicant does not agree), this somehow

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renders obvious all of the limitations of dependent claims 4-8, 10-11, and 16-20. The Examiner makes this conclusory leap with absolutely no discussion or analysis of the individual limitations found in dependent claims 4-8, 10-11, and 16-20.

Even assuming, for the sake of argument, that authentication servers, public key systems, and updating secure information is old and well-known (assertions with which Applicant does not agree), the Examiner has not shown, or even asserted, that it is well-known to use these elements in the manner claimed by Applicant. Indeed, taking the Examiner's logic to an extreme, "Official Notice" could always be taken that "software" is well-known to those skilled in the art, and thus an Examiner could avoid examining the claims of any software application.

Conclusion

As a result of the foregoing, it is asserted by Applicant that the remaining claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Applicant respectfully request that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By



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